

**REMARKS**

Claims 1-17 were presented for examination. Claims 1-3 and 12-17 were rejected. Claims 4-11 were objected to. Applicant is hereby amending claims 1, 4, 6, 9, 11 and 13-14 and canceling claim 2. Support for all amendments is found in the specification as originally filed. Reconsideration of this application as amended, and allowance of all pending claims are hereby respectfully requested.

**Rejection under 35 U.S.C. § 112**

Claims 13-14 have been rejected under 35 U.S.C. § 112 for insufficient antecedent basis. Claims 6, 9, 11 and 13-14 have been amended to address the Examiner's concerns and to overcome the rejection. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

**Rejection under 35 U.S.C. § 103**

Claims 1-3 and 12-17 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Chin (JP 09-244585) in view of Applicant's admitted prior art (AAPA). This rejection is respectfully traversed. Applicant respectfully requests reconsideration and allowance of the claims in view of the following arguments and amendments. For at least the reasons stated below, the proposed combination of Chin and AAPA, even if proper, does not disclose or suggest all of the required claim elements.

The present invention as recited in amended claim 1, for example, relates to a semiconductor device that includes a data capturing part for capturing a data signal and a latch part for holding the captured data signal. The data capturing part is substantially connected to a

power source during the capturing and determining of the data signal. Furthermore, as illustrated in FIG. 9 of the application, a pair of data input parts and a pair of data capturing parts drive the latch part.

Regarding independent claim 1, the Office Action apparently alleges that Chin discloses each of the claim elements, except for the determining feature of the data capturing part. In this regard, the Examiner relies on the AAPA to overcome the deficiencies of Chin. Applicant respectfully disagrees with the Examiner for at least the following reasons.

The Examiner has not discharged the initial burden of establishing a prima facie basis to deny patentability to the claimed invention. In rejecting a claim under § 103, the Examiner is required to identify a source in the applied prior art for: (1) claim limitations; and (2) the motivation to combine references or modify a reference in the reasonable expectation of achieving a particular benefit. In so doing, it is legally erroneous to ignore any claim limitation.

The Office Action ignores the claim recitation of “said data capturing part is substantially connected to a power source at least when capturing said data signal and determining said data signal” and does not explain how the claimed feature is shown in the proposed combination of references. Thus, the Office Action fails to establish a prima facie case of obviousness under § 103 because it does not identify a source in the applied references for all of the claim recitations.

Additionally, claim 1 has been amended to incorporate a feature that was previously recited in claim 2. Claim 2 has therefore been canceled. Even if the proposed combination of references were proper, the references do not teach or suggest all the elements of claim 1.

Neither Chin nor AAPA disclose or suggest “a pair of said data input parts and a pair of said data capturing parts respectively along with single said latch part” as recited in independent

claim 1 as amended. In contrast to the Applicant's claimed invention, Chin discloses a single data input part and a single data capturing part. One advantage of the claimed invention is improved stability in capturing and determining the data signal.

Even if the proposed combination of references were proper, the references do not teach or suggest each and every element of the claimed invention. Therefore, the references do not render independent claim 1 as amended as well as claims 3 and 12-17 which depend therefrom unpatentable.

Furthermore, regarding dependent claims 3 and 12-17, the Examiner has also not discharged the initial burden of establishing a prima facie basis to deny patentability. While the Office Action generally alleges that the proposed combination of references discloses all of the claim recitations, there is no identification of a source in the applied references for any of the features recited in claims 3 and 12-17. To deny an Applicant patentability, a rejection must be clear and particular. In this regard, the Office Action fails to meet this initial burden.

Reconsideration and withdrawal of the rejection of claims 1, 3 and 12-17 under 35 U.S.C. § 103 are respectfully requested.

#### **Allowable Subject Matter**

Applicant acknowledges with appreciation the indication that claims 4-11 include allowable subject matter. Claims 4-11 were objected to, however, as dependent on a rejected base claim. Claim 4 has been amended to incorporate the previously recited elements of claim 1 in independent format. Claims 5-11 depend from independent claim 4. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection to claims 4-11.

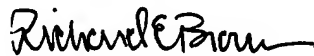
**Conclusion**

Accordingly, it is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Richard E. Brown  
Registration No. 47,453

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 REB:mcm  
Facsimile: (202) 756-8087  
**Date: June 28, 2004**